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10/519,456	12/29/2004	Kazumichi Kayama	AW-CS10	5371

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EXAMINER

HOLMES, JUSTIN K

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3681

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/519,456	Applicant(s) KAYAMA ET AL.	
	Examiner Justin K. Holmes	Art Unit 3681	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-34 and 37-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 20-34, 38 is/are allowed.
- 6) ☒ Claim(s) 39-42 is/are rejected.
- 7) ☒ Claim(s) 37 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Request for Continued Examination filed on June 18, 2007 is acknowledged.
2. The Examiner acknowledges receipt of the Amendment filed on July 19, 2007.

Accordingly, claims 20-34 and 37-42 are currently pending.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claim 40 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 2 of U.S. Patent No. 7,226,380 to Kayama et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because both of the claims define an input shaft, a decelerating planetary gear unit, an engaging means, a second planetary gear unit having long and short pinions, a first and second sun gears, carrier and ring gears, a first and second

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clutch and the positioning of the output element and clutches and engagement means are located in the same areas in both sets of claims.

Claim Objections

5. Claim 40 is objected to because of the following informalities: In line 15 of claim 40 the word "asecond" should read as --a second--. Appropriate correction is required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. Claims 41 and 42 are rejected under 35 U.S.C. 102(a) as being anticipated by U.S. Publication No. 2003/0109353 to Miyazaki et al.

Regarding claim 41 the Miyazaki et al. publication teaches an automatic transmission for a vehicle having, a rotatably driven input shaft 22; a decelerating first planetary gear unit 10 comprising an input rotary component s1 that receives as input the rotation of said input shaft 22, a decelerated rotary component r1 that rotates at a speed decelerated from the speed of rotation of the input rotary component s1 and an intermediate component ca1 for transfer of rotation from said input rotary component s1 to said decelerated rotary component r1; engaging means b3 for controlling rotation of said intermediate component ca1; a second planetary gear unit 20 comprising a first rotary element s2, a second rotary element r2 , a third rotary element s3 and a fourth rotary element ca3, said second planetary gear unit 20 receiving input of the

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decelerated rotation of said decelerated rotary component r1; a first clutch c1 for connecting and disconnecting said input shaft 22 to and from said second rotary element s2; a second clutch c2 for connecting and disconnecting said input shaft to 22 and from said third rotary element r2; and an output member 24 for outputting the rotation of said fourth rotary element ca3 to drive wheels of the vehicle; wherein said first clutch c1 and said second clutch c2 each comprises friction members and a hydraulic servo for engaging said friction members (see page 3 paragraph 21); wherein said automatic transmission provides at least five forward speeds and one reverse speed, and said first clutch and said second clutch are engaged together in fourth speed forward (See Fig. 1B); wherein said first planetary gear unit 10 and said engaging means b3 are located on one side of said second planetary gear unit 20; wherein said hydraulic servo of the first clutch c1 and said hydraulic servo of the second clutch c2 are located on a side of said second planetary gear unit 20 axially opposite said one side; and wherein said output member 24 is disposed between said second planetary gear unit 20 and said first planetary gear unit 10 and said engaging means b3. See Fig. 1A.

Regarding claim 42, the Miyazaki et al. publication teaches an automatic transmission for a vehicle having, a rotatably driven input shaft 22; a decelerating first planetary gear unit 10 comprising an input rotary component s1 that receives as input the rotation of said input shaft 22, a decelerated rotary component r1 that rotates at a speed decelerated from the speed of rotation of the input rotary component s1 and an intermediate component ca1 for transfer of rotation from said input rotary component s1 to said decelerated rotary component r1; engaging means b3 for controlling rotation of

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said intermediate component ca1; a second planetary gear unit 20 comprising a first rotary element s2, a second rotary element r2, a third rotary element s3 and a fourth rotary element ca3, said second planetary gear unit 20 receiving input of the decelerated rotation of said decelerated rotary component r1; a first clutch c1 for connecting and disconnecting said input shaft 22 to and from said second rotary element s2; a second clutch c2 for connecting and disconnecting said input shaft to 22 and from said third rotary element r2; a brake b2 for braking said second rotary element r2; a one-way clutch f for preventing rotation of said second rotary element r2 in one direction; and an output member 24 for outputting the rotation of said fourth rotary element ca3 to drive wheels of the vehicle; wherein said automatic transmission provides at least five forward speeds and one reverse speed, and said first clutch and said second clutch are engaged together in fourth speed forward (See Fig. 1B); wherein said first planetary gear unit 10 and said engaging means b3 are located on one side of said second planetary gear unit 20; wherein said first clutch c1 and said second clutch c2 are located on a side of said second planetary gear unit 20 axially opposite said one side; wherein said brake b2 and said one way clutch f are located outside of said second planetary gear unit 20; wherein said brake b2 is located on a side of said one way clutch f axially opposite said one side; and wherein said output member 24 is disposed between said second planetary gear unit 20 and said first planetary gear unit 10 and said engaging means b3. See Fig. 1A.

Accordingly, all the elements of claims 41 and 42 are anticipated by the Miyazaki et al. publication.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.

Publication No. 2003/0109353 to Miyazaki et al. in view of U.S. Patent No. 6,176,802 to Kasuya et al.

The Miyazaki et al. publication teaches publication teaches an automatic transmission for a vehicle having, a rotatably driven input shaft 22; a decelerating first planetary gear unit 10 comprising an input rotary component s1 that receives as input the rotation of said input shaft 22, a decelerated rotary component r1 that rotates at a speed decelerated from the speed of rotation of the input rotary component s1 and an intermediate component ca1 for transfer of rotation from said input rotary component s1 to said decelerated rotary component r1; a first brake b3 for braking said intermediate component ca1; a second planetary gear unit 20 comprising a first rotary element s2, a second rotary element r2 , a third rotary element s3 and a fourth rotary element ca3, said second planetary gear unit 20 receiving input of the decelerated rotation of said decelerated rotary component r1; a first clutch c1 for connecting and disconnecting said input shaft 22 to and from said second rotary element s2; a second clutch c2 for connecting and disconnecting said input shaft to 22 and from said third rotary element r2; and an output member 24 for outputting the rotation of said fourth rotary element ca3

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to drive wheels of the vehicle; a case 26 housing the first 10 and second 20 planetary gear units; wherein the first brake b3 is located on the side of the first planetary gear unit 10 axially opposite the second planetary gear unit 20; wherein said automatic transmission provides at least five forward speeds and one reverse speed, and said first clutch and said second clutch are engaged together in fourth speed forward (See Fig. 1B); wherein said first planetary gear unit 10 and said first brake b3 are located on one side of said second planetary gear unit 20; wherein said first clutch c1 and said second clutch c2 are located on a side of said second planetary gear unit 20 axially opposite said one side; and wherein said output member 24 is disposed between said second planetary gear unit 20 and said first planetary gear unit 10 and said first brake b3. See Fig. 1A.

However, the Miyazaki et al. publication lacks a teaching that the hydraulic servo of the first brake has a cylinder formed in the case.

The Kasuya et al. patent teaches a brake b-2 having a hydraulic servo with a cylinder formed in a front wall portion of a transmission case. See Fig. 14 and column 21, lines 40-45.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the Miyazaki et al. publication to include the hydraulic servo with a cylinder formed in the casing as taught in the Kasuya et al. patent in order to shorten the overall length of the case. See column 21, lines 46-53 of the Kasuya et al. patent.

Allowable Subject Matter

10. Claims 20-34 and 38 are allowed.
11. Claim 37 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Facsimile Transmission

Submission of your response by facsimile transmission is encouraged. Group 3600's facsimile number is (571) 273-8300. Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly in our examining group's hands and will eliminate Post Office processing and delivery time as well as the PTO's mail room processing and delivery time. For a complete list of correspondence not permitted by facsimile transmission, see MPEP 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check should not be submitting by facsimile transmission separately from the check.

Responses submitted by facsimile transmission should include a Certificate of Transmission (MPEP 512). The following is an example of the format the certification might take:

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(Signature)

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin K. Holmes whose telephone number is (571) 272-5930. The examiner can normally be reached on 8:00am to 4:30pm Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles A. Marmor can be reached on (571) 272-7095. The fax phone


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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


JKH

7/27/07


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ART UNIT 3681